

REMARKS

By this amendment, Applicant cancels claims 7, 16-18, 23, and 34, and amends claims 1, 2, 5, 15, 19, 28, and 32. Claim 5 has been amended to incorporate limitations of canceled claim 7. Claim 15 has been amended to incorporate limitations of canceled claims 16 and 17. Claim 19 has been amended to incorporate limitations of canceled claims 18 and 23. Claim 32 has been amended to incorporate limitations of canceled claim 34. Support for these amendments can further be found in the specification at, for example, Figs. 3, 4, 6, and 19, and pages 17-19, pages 20-23, and page 29. Following this amendment, claims 1-6, 8-15, 19-22, 24-33, and 35-40 are pending in this application.

In the Office Action¹ ("OA") mailed September 28, 2005, the Examiner rejected claims 1-4 and 15-31 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,587,835 to Treyz et al. ("*Treyz*"). The Examiner also rejected claims 5-14 and 32-40 under 35 U.S.C. § 103(a) as being unpatentable over *Treyz*. In view of the following remarks, Applicant respectfully traverses the rejections of claims 1-40 under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a).

§ 102(e) Rejections

The Examiner rejected Claims 1-4 and 15-31 under 35 U.S.C. § 102(e) as being anticipated by *Treyz*. Applicant respectfully traverses this rejection.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

In order to properly anticipate Applicant's claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in...the claim." See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed., 2001), p. 2100-69.

1. Claims 1-4, 9, 19-22, and 24-31

Applicant respectfully submits that *Treyz* does not disclose or suggest the claimed combination of steps as recited in amended claim 1. For example, the reference does not disclose or suggest: "an information collecting apparatus for erasing the electronic guide information from the portable terminal apparatus at an exit of the facility and writing in the portable terminal apparatus at least one of information about use status of the customers attracting facility by the information user and advertisement information about the customers attracting facility," as recited in amended claim 1.

Treyz discloses a handheld computing device that provides a user with shopping assistance (*Treyz* abstract). The shopping assistance service provides the user with the opportunity to purchase an electronic ticket (*Treyz* Fig. 12), communicate with communication equipment in retail establishments using a local wireless link (*Treyz* Figs. 16, 17, 20, and 35; col. 22, ll. 16-28 and col. 35², ll. 21-40), and display promotional materials based on the shopping lists (*Treyz* Figs. 86-88 and 96). Moreover, the location of the handheld computing device utilizing the shopping assistance service may

be monitored (*Treyz* Fig. 71, 73, and 96). However, neither this portion of *Treyz*, nor any other portion constitutes: “an information collecting apparatus for erasing the electronic guide information from the portable terminal apparatus at an exit of the facility and writing in the portable terminal apparatus at least one of information about use status of the customers attracting facility by the information user and advertisement information about the customers attracting facility” (emphasis added), as recited in amended claim 1.

For at least the foregoing reasons, Applicant submits that amended claim 1 is not anticipated by *Treyz*. Because independent claims 19 and 28, although of different scope, have distinguishing features similar to those of amended claim 1, Applicant further submits that claims 19 and 28 are also not anticipated by *Treyz* for at least the reasons given with respect to amended claim 1.

Dependent claims 2-4, 20-22, 24-27, and 29-31 are allowable not only for the reasons stated above with regard to their respective allowable base claims, but also for their own additional features that distinguish them from *Treyz*. Accordingly, Applicant requests withdrawal of the rejection under 35 U.S.C. § 102(e) and the timely allowance of claims 1-4, 19-22, and 24-31.

2. Claim 15

Applicant respectfully submits that *Treyz* does not disclose or suggest the claimed combination of steps as recited in amended claim 15. For example, the reference does not disclose or suggest: “a data inserting section for constructing electronic information contents about the guide information into data strings, and

multiplexing the data strings into a vertical blanking interval of a television broadcasting signal for transmission,” as recited in amended claim 15.

As discussed above, *Treyz* discloses a handheld computing device that provides a user with shopping assistance (*Treyz* abstract). The shopping assistance service communicates with the handheld computing device through, for example, wireless radio frequencies, a wireless local area network, cellular telephone links, satellite links, and FM data services (*Treyz* Fig. 1; col. 12, l. 56-col. 13, l. 47). However, neither this portion of *Treyz*, nor any other portion constitutes: “a data inserting section for constructing electronic information contents about the guide information into data strings, and multiplexing the data strings into a vertical blanking interval of a television broadcasting signal for transmission” (emphasis added), as recited in amended claim 15.

For at least the foregoing reasons, Applicant submits that amended claim 15 is not anticipated by *Treyz*. Accordingly, Applicant request withdrawal of the rejection under 35 U.S.C. § 102(e) and the timely allowance of amended claim 15.

§ 103(a) Rejections

The Examiner rejected claims 5-14 and 32-40 under 35 U.S.C. § 103(a) as being unpatentable over *Treyz*. Applicant respectfully traverses this rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference as modified must teach or suggest all the claim elements. (See M.P.E.P. § 2143.03 (8th ed. 2001)). Second, there must be some suggestion or

motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. (See M.P.E.P. § 2143 (8th ed. 2001)). Third a reasonable expectation of success must exist. Moreover, each of these requirement must "be found in the prior art, and not be based on applicant's disclosure." (M.P.E.P. § 2143.03 (8th ed. 2001)).

Applicant traverses the rejection of claims 5-14 and 32-40 under 35 U.S.C. § 103(a) because a prima facie case of obviousness has not been established based on *Treyz*. With respect to claim 5, the Examiner admitted that *Treyz*, "fails to expressly disclose wherein the system performs processing such that the reading of the electronic guide information is permitted at the entrance, while the reading of the electronic guide information is inhibited at the exit" (OA at page 8, ¶27), as recited in claim 5. The Examiner then alleged that *Treyz* discloses "transmitting information in a set area or perimeter, and activating transmission upon entrance to the facility" (OA at page 8, ¶28). Next, in an apparent Official Notice, the Examiner stated that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein ... the reading of the electronic guide information is permitted at the entrance [but] inhibited at the exit in the system disclosed by *Treyz*" (OA at page 8, ¶29) in order to "increase efficiency and business effectiveness of the system, by controlling user access to the provided information." (OA at page 8, ¶29).

Applicant agrees with the Examiner that *Treyz* does not teach or suggest that "the system performs processing such that the reading of the electronic guide information is permitted at the entrance, while the reading of the electronic guide information is inhibited at the exit," as recited in amended claim 5. Furthermore, as

discussed above, *Treyz*'s teaching of a handheld computing device that provides a user with shopping assistance does not constitute a disclosure that "when the electronic guide information is collected at the exit, the electronic guide information is erased, and at least one of information about use status of the customers attracting facility by the information user and advertisement information about the customers attracting facility is written in the portable terminal apparatus" (emphasis added), as recited in amended claim 5. Therefore, *Treyz* fails to teach or suggest each and every element of amended claim 5.

With respect to claim 5, the Examiner did not fully address the elements recited in claim 5, other than to generally conclude that "it would have been obvious to one of ordinary skill in the art... to apply the teaching of *Treyz*" (OA at page 5, ¶12). As M.P.E.P. § 2144.03(B) makes clear,

there must be some form of evidence in the record to support an assertion of common knowledge ... general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection. ... The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made

(emphasis added, internal citations omitted). Applicant respectfully submits that the Examiner's general conclusions are not sufficient to support a rejection under 35 U.S.C. § 103(a). Applicant requests that the Examiner provide documentary evidence, supported with sound technical and scientific reasoning, teaching each and every element of Applicant's dependent claims. For at least these additional reasons,

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Treyz*.

Independent claim 32, although of different scope, recites elements similar to elements recited by amended claim 5. Therefore, Applicant submits that the rejection of claim 32 is not supported by *Treyz*, for at least the reasons given with respect to amended claim 5, and respectfully request that the Examiner reconsider and withdraw the rejection of claim 32 under 35 U.S.C. § 103(a) as being unpatentable over *Treyz*. The rejection of dependent claims 6, 8-14, 33, and 35-40 are unsupportable for at least the reasons stated above with regard to their respective allowable base claims. Accordingly, Applicant requests withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of claims 5, 6, 8-14, 32, 33, and 35-40.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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